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In re Application of
Tae-Young Kil
Application No. 09/801,807
Filed: March 9, 2001
For: **METHOD AND APPARATUS FOR
ALARMING ON OCCURRENCE OF
CELL SECESSION OF A MOBILE
STATION IN A MOBILE
COMMUNICATION SYSTEM**

DECISION ON PETITION
UNDER 37 CFR 1.181
FOR ENTRY OF AMENDMENT

This is a decision on the Petition pursuant to 37 C.F.R. § 1.181(a), filed October 19, 2004, requesting the Commissioner to invoke his supervisory authority and to direct the examiner to enter the After Final Amendment, filed August 19, 2004. No fee is required.

BACKGROUND

The Final Office Action mailed on May 19, 2004 required applicant to correct the minor informality of claim 31 by including the period missing at the end of claim 31. In addition, the Final Office Action included a rejection of claims 25-31 under 35 USC 103 as being unpatentable over the combination of McClelland et al. (U.S. Patent Number 6,330,438 B1) in view of Khan et al. (U.S. Patent Number 5,926,760) and further in view of Hong (U.S. Patent Number (6,298,241)).

An Amendment After Final was filed on August 19, 2004 in response to the May 19, 2004 Final Office Action. The Amendment After Final cancelled claims 25-31 and added new claims 32-35 substituted for claims 25-31.

An Advisory Action was mailed on October 6, 2004 in response to the Amendment After Final. The Advisory action denied entry of the proposed amendment because it was not deemed that the proposed amendment placed the application in better form for appeal by materially reducing or simplifying the issues for appeal.

The petitioner contends that new claims 32-35 were rewritten to improve their clarity without changing their scope. In addition, the petitioner reasons that minor informalities including those noted by the examiner were corrected thus meeting all of the statutory requirements of 35 USC 112 as to form.

REGULATIONS AND PRACTICE

MPEP § 714.12 states in part that:

Once a final rejection that is not premature has been entered in the case, applicant or patent owner no longer has any right to unrestricted further prosecution... Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a).

37 CFR § 1.116(a) and (b) state that:

(a) After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

MPEP § 714.13 states in part that:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after final rejection (see 37 CFR 1.116) or reinstate previously rejected claims.

... compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

- (A) an amendment complying with 37 CFR 1.116;
- (B) a Notice of Appeal (and appeal fee); or
- (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e).

... An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

MPEP § 1207 states in part that:

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues from appeal, and/or (2) adopt examiner's suggestions. Of course, if the amendment necessitates a new search, raises the issue of new matter, presents additional claims without canceling a corresponding number of finally rejected claims, or otherwise introduces new issues, it will not be entered.

OPINION

37 CFR 1.116(b) states in part that “amendments [after final] may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office Action”. 37 CFR 1.116(b) also states that “amendments presenting rejected claims in better form for consideration on appeal may be admitted”.

In the instant application, the amendment is not entered as a matter of right as evidenced by the examiner's Advisory Action. The amendment to claim 32 (lines 12, 15, 18, 22 and 24) and claim 34 (lines 7, 15 and 18-19) requiring comparing “in the base station”, determining the power level and the registration of the mobile station “in the base station”, transmitting cell secession information “from the base station” and an analyzer “arranged within the base station” changes the scope of the claims as well as fails to materially reduce or simplify the issues for appeal.

Compliance with the requirement of form set forth in the Final Office Action only required applicant to place a period at the end of claim 31.

DECISION

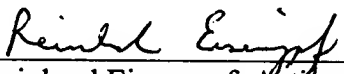
A review of the file record indicates that the proposed After Final Amendment to claim 32 (lines 12, 15, 18, 22 and 24) and claim 34 (lines 7, 15 and 18-19) requiring comparing "in the base station", determining the power level and the registration of the mobile station "in the base station", transmitting cell secession information "from the base station" and an analyzer "arranged within the base station" was not presented prior to the issuance of the Final Office Action. Subsequently, the After Final Amendment raises new issues requiring further consideration and/or search.

Accordingly, the petition is DENIED.

The Advisory Action, mailed October 6, 2004 inadvertently failed to indicate that new issues were also raised by the Amendment After Final, filed August 19, 2004. Accordingly, the examiner has generated a Supplemental Advisory Action, which is attached herewith.

Any inconvenience to applicant is regretted.

The application file is being returned to await Appellant's Brief.


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Enclosure: Supplemental Advisory Action